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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/829,067	04/21/2004	Isaac Lagnado	200313247-1	6812

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EXAMINER

MILLER, BRANDON J

ART UNIT	PAPER NUMBER
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2617

DATE MAILED: 09/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/829,067	<b>Applicant(s)</b> LAGNADO, ISAAC	
	<b>Examiner</b> Brandon J. Miller	<b>Art Unit</b> 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 26 June 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-60 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response*

#### *Declaration Under 37 C.F.R §1.131*

The declaration filed on 06/26/2006 under 37 CFR 1.131 has been considered but is ineffective to overcome the Buckley (US 2005/0148299 A1) reference.

The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Buckley reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897).

For instance, claim 1 specifically recites: A method for accessing a wireless network, comprising: detecting at least one wireless network within which a wireless device is located while the wireless device in a transmit off mode; and determining whether the at least one wireless network is on a list of requested wireless networks.

Furthermore, claim 28 specifically recites: The system of claim 26, wherein the application logic is adapted to switch the wireless device to transmit on mode in response to determining that the at least one wireless network is on a list of requested wireless networks.

In contrast to claims 1 and 28, Exhibit A of the enclosed declaration merely discloses a WLAN Quiet Mode that enables a WLAN device to always be in quiet mode during its scanning/not connected states until it receives a valid wireless network SSID. The declaration

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also discloses continually transmitting Probe request of all SSID that are configured on the devices requested list. However, it is not obvious from the disclosure in Exhibit A that there should be any determining whether the at least one wireless network is on a list of requested wireless networks and switching the wireless device to transmit on mode in response to determining that the at least one wireless network is on a list of requested wireless networks. For these reasons the evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Buckley reference.

The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Buckley reference to either a constructive reduction to practice or an actual reduction to practice because applicant has failed to provide evidence of due diligence from a time prior to January 7, 2004 through April 21, 2004, which was the filing date of the pending application (10/829,067).

Applicant must account for the entire period during which diligence is required. *Gould v. Schawlow*, 363 F.2d 908, 919, 150 USPQ 634, 643 (CCPA 1966) (Merely stating that there were no weeks or months that the invention was not worked on is not enough); *In re Harry*, 333 F.2d 920, 923, 142 USPQ 164, 166 (CCPA 1964) (statement that the subject matter “was diligently reduced to practice” is not a showing but a mere pleading). A 2-day period lacking activity has been held to be fatal. *In re Mulder*, 716 F.2d 1542, 1545, 219 USPQ 189, 193 (Fed. Cir. 1983) (37 CFR 1.131 issue).

The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the Buckley reference because, as recited by claims 1 and 28 respectively, determining whether the at least one wireless network is on a list of requested wireless networks and switching the wireless device to transmit on mode in response to determining that the at least one wireless network is on a list of requested wireless networks has not been shown by the disclosure in Exhibit A.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-10, 15-17, 19-23, 25-33, 36-40, 42-43, 46-48, 50-55 and 57-60 are rejected under 35 U.S.C. 102(e) as being anticipated by Buckley.

Regarding claim 1 Buckley teaches a method for accessing a wireless network (see paragraph [0003]). Buckley teaches detecting at least one wireless network within which a wireless device is located while the wireless device is in a transmit off mode (see paragraph [0016], transmit off mode relates to passive mode). Buckley teaches determining whether the at

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least one wireless network is on a list of requested wireless networks (see paragraph [0016] and Fig. 4).

Regarding claim 2 Buckley teaches wherein detecting comprises receiving at least one beacon frame from the at least one wireless network (see paragraph [0012]).

Regarding claim 3 Buckley teaches switching the wireless device to a transmit on mode and transmitting an access request to the at least one wireless network in response to determining that the at least one wireless network is on the list of requested wireless networks (see paragraph [0017], sending authentication data relates to transmit on mode).

Regarding claim 4 Buckley teaches automatically switching the wireless device to a transmit on mode in response to determining the at least one wireless network is on the list of requested wireless networks (see paragraphs [0016] and [0017], sending authentication relates to transmit on mode).

Regarding claim 5 Buckley teaches creating a scan list of wireless networks within which the wireless device is located (see paragraphs [0012] & [0013]).

Regarding claim 6 Buckley teaches wherein the scan list comprises an identifier of the at least one wireless network (see paragraphs [0012] & [0013]).

Regarding claim 7 Buckley teaches wherein the scan list comprises an identifier having a service set identifier (SSID) (see paragraphs [0012] & [0013]).

Regarding claim 8 Buckley teaches the scan list comprising a set of attributes of the at least one wireless network (see paragraph [0013], hierarchical preference status relates to set of attributes).

Regarding claim 9 Buckley teaches comparing a set of attributes of a scan list associated with the at least one wireless network with a set of attributes in the list of requested wireless networks (see paragraph [0013], hierarchical preference status relates to set of attributes).

Regarding claim 10 Buckley teaches comparing a scan list associated with the list of requested wireless networks to determine whether the at least one wireless network is on the list of requested wireless networks (see paragraph [0012]).

Regarding claim 15 Buckley teaches at least one wireless local area network within which the wireless device is located (see paragraph [0016]).

Regarding claim 16 Buckley teaches a method for accessing a wireless network (see paragraph [0003]). Buckley teaches automatically switching a wireless device to a transmit off mode in response to activation of the wireless device (see paragraph [0016], transmit off mode relates to passive mode). Buckley teaches detecting at least one wireless network within which the wireless device is located while the wireless device is in the transmit off mode (see paragraph [0016] and Fig. 4).

Regarding claim 17 Buckley teaches determining whether the at least one wireless network is on a list of requested wireless networks (see paragraph [0016] and Fig. 4).

Regarding claim 19 Buckley teaches a device as recited in claim 2 and is rejected given the same reasoning as above.

Regarding claim 20 Buckley teaches a device as recited in claim 5 and is rejected given the same reasoning as above.

Regarding claim 21 Buckley teaches comparing a list of requested wireless networks with a scan list of wireless networks within which the wireless device is located (see paragraph [0013]).

Regarding claim 22 Buckley teaches automatically switching the wireless device to a transmit on mode if the at least one wireless network is on the list of requested wireless networks (see paragraph [0016] & [0017], sending authentication data relates to transmit on mode).

Regarding claim 23 Buckley teaches a device as recited in claim 15 and is rejected given the same reasoning as above.

Regarding claim 25 Buckley teaches switching the wireless device to a transmit on mode and requesting access to at the at least one wireless network in response to determining that the at least one wireless network is on a list of requested wireless networks (see paragraphs [0016] and [0017], sending authentication relates to transmit on mode).

Regarding claim 26 Buckley teaches a system for accessing a wireless network, comprising a wireless device; and application logic operatively associated with the wireless device (see paragraph [0016] and Fig. 4). Buckley teaches switching the wireless device to a transmit off mode (see paragraph [0016], transmit off mode relates to passive mode after activation). Buckley teaches detecting at least one wireless network within which the wireless device is located while in the transmit off mode (see paragraph [0016] and Fig. 4).

Regarding claim 27 Buckley teaches a device as recited in claim 17 and is rejected given the same reasoning as above.

Regarding claim 28 Buckley teaches a device as recited in claim 4 and is rejected given the same reasoning as above.



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Regarding claim 29 Buckley teaches a device as recited in claim 3 and is rejected given the same reasoning as above.

Regarding claim 30 Buckley teaches a device as recited in claim 2 and is rejected given the same reasoning as above.

Regarding claim 31 Buckley teaches a device as recited in claim 5 and is rejected given the same reasoning as above.

Regarding claim 32 Buckley teaches a device as recited in claim 8 and is rejected given the same reasoning as above.

Regarding claim 33 Buckley teaches a device as recited in claim 10 and is rejected given the same reasoning as above.

Regarding claim 36 Buckley teaches a device as recited in claim 15 and is rejected given the same reasoning as above.

Regarding claim 37 Buckley teaches a system for accessing a wireless network (see paragraph [0003]). Buckley teaches switching the wireless device to a transmit off mode (see paragraph [0016], transmit off mode relates to passive mode after activation). Buckley teaches detecting at least one wireless network within which the wireless device is located while in the transmit off mode (see paragraph [0016] and Fig. 4).

Regarding claim 38 Buckley teaches a device as recited in claim 4 and is rejected given the same reasoning as above.

Regarding claim 39 Buckley teaches a device as recited in claim 17 and is rejected given the same reasoning as above.

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Regarding claim 40 Buckley teaches a device as recited in claim 5 and is rejected given the same reasoning as above.

Regarding claim 42 Buckley teaches a system for accessing a wireless network (see paragraph [0003]). Buckley teaches application logic operatively associated with the wireless device (see paragraph [0016] and Fig. 4). Buckley teaches the application logic adapted to selectively switch the wireless device between a transmit off mode and a transmit on mode based on an identification of at least one wireless network (see paragraphs [0016] and [0017], passive mode relates to transmit off mode and sending authentication data relates to transmit on mode).

Regarding claim 43 Buckley teaches wherein the at least one wireless network comprises a wireless local area network (see paragraph [0003]).

Regarding claim 46 Buckley teaches a device as recited in claim 4 and is rejected given the same reasoning as above.

Regarding claim 47 Buckley teaches a device as recited in claim 5 and is rejected given the same reasoning as above.

Regarding claim 48 Buckley teaches a device as recited in claim 4 and is rejected given the same reasoning as above.

Regarding claim 50 Buckley teaches automatically switching a wireless device to a transmit off mode in response to activation of the wireless device (see paragraph [0016], transmit off mode relates to passive mode).

Regarding claim 51 Buckley teaches switching the wireless device to a transmit on mode and transmitting an access request to the identified wireless network (see paragraph [0017], sending authentication data relates to transmit on mode).

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Regarding claim 52 Buckley teaches a method for accessing a wireless network (see paragraph [0003]). Buckley teaches automatically detecting at least one wireless network within which a wireless device is located while the wireless device is on and in a transmit off mode (see paragraph [0016], transmit off mode relates to passive mode after activation).

Regarding claim 53 Buckley teaches a device as recited in claim 17 and is rejected given the same reasoning as above.

Regarding claim 54 Buckley teaches a device as recited in claim 4 and is rejected given the same reasoning as above.

Regarding claim 55 Buckley teaches a device as recited in claim 5 and is rejected given the same reasoning as above.

Regarding claim 57 Buckley teaches a system for accessing a wireless network, comprising a wireless device (see paragraph [0003]). Buckley teaches application logic operatively associated with the wireless device (see paragraph [0016] and Fig. 4). Buckley teaches application logic adapted to automatically detect at least one wireless network within which the wireless device is located while the wireless device is on and in a transmit off mode (see paragraph [0016], transmit off mode relates to passive mode after activation).

Regarding claim 58 Buckley teaches a device as recited in claim 17 and is rejected given the same reasoning as above.

Regarding claim 59 Buckley teaches a device as recited in claim 4 and is rejected given the same reasoning as above.

Regarding claim 60 Buckley teaches a device as recited in claim 5 and is rejected given the same reasoning as above.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11-14, 18, 24, 34-35, 41, 49, 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buckley in view of Whelan.

Regarding claim 11 Buckley teaches a device as recited in claim 1 except for determining whether the at least one wireless network is a wireless network whose identifier is unknown. Whelan teaches determining whether a wireless network device is a wireless network device whose identifier is unknown (see paragraph [0036]). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the device adapt to include determining whether the at least one wireless network is a wireless network whose identifier is unknown because this would allow for improved security of wireless networks.

Regarding claim 12 Buckley teaches a device as recited in claim 11 except for switching the wireless device to a transmit on mode to identify an unknown wireless network. Buckley does teach switching a wireless device to a transmit on mode (see paragraph [0017], sending authentication data relates to transmit on mode). Whelan does teach identifying an unknown wireless network device (see paragraph [0036]). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the device adapt to include switching the wireless device to a transmit on mode to identify an unknown wireless network because this would allow for improved security of wireless networks.

Regarding claim 13 Whelan teaches transmitting at least one probe request frame to identify an unknown wireless network (see paragraph [0034]).

Regarding claim 14 Whelan teaches receiving a probe response frame from the unknown wireless network, the probe response frame having an identifier for identifying the unknown wireless network (see paragraph [0034]).

Regarding claim 18 Buckley and Whelan teach a device as recited in claim 11 and is rejected given the same reasoning as above.

Regarding claim 24 Buckley teaches a device as recited in claim 16 except for switching the wireless device to a transmit on mode in response to determining that the at least one wireless network is a wireless network whose identifier is unknown; and transmitting a probe request frame to the at least one wireless network to identify the at least one wireless network. Buckley does teach switching a wireless device to a transmit on mode (see paragraph [0017], sending authentication data relates to transmit on mode). Whelan does teach determining whether a wireless network device is a wireless network device whose identifier is unknown (see paragraph [0036]). Whelan does teach transmitting at least one probe request frame to identify an unknown wireless network (see paragraph [0034]). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the device adapt to include switching the wireless device to a transmit on mode in response to determining that the at least one wireless network is a wireless network whose identifier is unknown; and transmitting a probe request frame to the at least one wireless network to identify the at least one wireless network because this would allow for improved security of wireless networks.

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Regarding claim 34 Buckley and Whelan teach a device as recited in claim 11 and is rejected given the same reasoning as above.

Regarding claim 35 Buckley and Whelan teach a device as recited in claim 24 and is rejected given the same reasoning as above.

Regarding claim 41 Buckley and Whelan teach a device as recited in claim 24 and is rejected given the same reasoning as above.

Regarding claim 49 Buckley and Whelan teach a device as recited in claim 24 and is rejected given the same reasoning as above.

Regarding claim 56 Buckley and Whelan teach a device as recited in claim 11 and is rejected given the same reasoning as above.

Claims 44-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buckley in view of Krantz.

Regarding claim 44 Buckley teaches a device as recited in claim 42 except for the at least one wireless network comprising an infrastructure network. Krantz teaches at least one wireless network comprising an infrastructure network (see paragraph 0029]). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the device adapt to include at least one wireless network comprising an infrastructure network because it is a method of wireless communication and it would allow for efficient networking of devices.

Regarding claim 45 Buckley teaches a device as recited in claim 42 except for the at least one wireless network comprising an ad-hoc. Krantz teaches at least one wireless network comprising an ad-hoc network (see paragraph 0029]). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the device adapt to include at

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least one wireless network comprising an ad-hoc network because it is a method of wireless communication and it would allow for efficient networking of devices.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Yahagi Pub. No.: US 2002/0102978 A1 discloses multi-network communications systems.

Zhao et al. Pub. No.: US 2005/0048986 A1 discloses methods, systems and computer program products for directing a user to a wireless network access point.

Yoshimoto et al. U.S. Patent No. 6,970,705 discloses multipoint communication system and multipoint communication method.

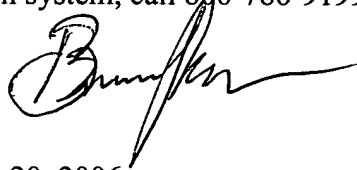
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brandon J. Miller whose telephone number is 571-272-7869.

The examiner can normally be reached on Mon.-Fri. 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Eng can be reached on 571-272-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



September 20, 2006



GEORGE ENG  
SUPERVISORY PATENT EXAMINER